

REMARKS/ARGUMENT

In a non-final office action mailed 27 October 2006, pending claims 1-20 were rejected. As set forth below, the applicants respectfully traverse the rejections and, in conjunction with the following remarks, submit that all claims are allowable over the cited art.

The office action raised essentially two issues. First, the abstract was objected to under MPEP § 608.01(b) due to an alleged defect. Second, all claims were rejected under 35 USC § 102 in view of the Janek reference.

Abstract

The office action contains an objection to the abstract and alleges that “inter alia” is a legal term. The applicants respectfully submit that “inter alia” is not a legal term. Much like the term “et alii” used by the Patent Office in the present application when referring to the inventors, the term “inter alia” is a commonly-used Latin phrase having no legal effect. Specifically, the Random House Dictionary defines “inter alia” as “among other things.”¹

The MPEP section cited in the office action makes reference to the words “said” and “means” as examples of the sort of legalisms that ought to be avoided. As stated in 37 CFR § 1.72, “[t]he purpose of the abstract is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure.” Legalisms such as “said” and “means” are buzz words invoking the requirements 35 USC § 112; a subtlety which may confuse members of the public not familiar with the intricacies of claim language. By contrast, commonly known Latin phrases like “et alii” and “inter alia” are not buzz words having legal effect and are not likely to cause confusion of the sort identified by the exemplary terms to avoid. Accordingly, the policy requiring avoidance of “said” and “means” is not applicable to terms like “inter alia” that have no legal effect.

¹ <http://dictionary.reference.com/browse/inter%20alia>, accessed 24 April 2007.

Consequently, the applicants respectfully submit that the objection is improper and should be withdrawn.

Rejections under 35 USC §102

The office action rejected all pending claims as anticipated under 35 USC § 102(b) by the Janek reference. To support a rejection under § 102, a prior art reference must disclose each and every element and limitation in the rejected claim. MPEP 2131. Omission of any claimed element or limitation, no matter how insubstantial, is grounds for traversing a rejection based on §102. MPEP 2131.

Claims 1-12

Regarding claim 1, the office action asserts that the container in the Janek reference “is adapted for secure and substantial engagement with a surface 32... It may be positioned in a first and second orientation on that surface...” Based on this characterization, the office action rejects claim 1. The applicants respectfully submit, however, that the Janek reference does not disclose each and every element of the applicants’ invention as recited in claim 1.

Specifically, the applicants’ claim 1 requires a container “suitably adapted for substantially secure engagement with a surface, wherein said engagement of said container with said surface permits the container to be positioned in at least a first orientation and a second orientation.” In the Janek reference, however, the secure engagement permits only one orientation. In particular, when the container 20 is secured to the surface 32 via the attachment latch 73 for “secure engagement” as noted in the office action, only one orientation is possible. As illustrated in Figures 1 and 2 of the reference, the locking pins 63 and 64 must disengage from the attachment latch 73 before the container 32 may be reoriented with respect to the surface 32, which is not a secure engagement. As such, the substantially secure engagement of the Janek reference permits only a single position; moving to a second position requires release of the secure engagement.

More particularly, the Janek reference expressly confirms that secure engagement of the container 20 allows only one position. For example, as illustrated in Figure 3 and as specifically noted in the Janek reference at column 9, lines 47-51:

It is essential that the locking means locks the one side of the base of the tub at two longitudinally spaced-apart positions on the one side of the monorail, and also at a third position opposite one of the spaced-apart positions. Such a configuration for the locking means is shown in FIG. 3 in which the pivot latches 71 and 72 are in the spaced-apart positions, and attachment latch 73 is at the third position.”

This portion of the Janek reference illustrates that when the container 20 is securely engaged to the surface 32, it must be secured with at least three latches 71, 72, and 73. When these three latches are secured, the container cannot be positioned in any other orientation. By contrast, the applicants’ claim 1 explicitly requires a container securely engaged such that the container is permitted to reorient in at least a first and second position. Accordingly, the Janek reference does not disclose each and every limitation of the applicants’ claimed invention. Because claim 1 is patentable over the cited reference and by definition all claims which depend from claim 1 are narrower in scope, the applicants respectfully traverse the rejections regarding claims 1-12 and respectfully request that the rejections be withdrawn.

Furthermore, even if the Janek reference were considered in a § 103 obviousness context, the applicants’ claimed invention would not be obvious in view of the Janek reference. As stated in MPEP 2143, three criteria must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to skilled artisans, to modify the reference. Second, there must be a reasonable expectation of success. Third, the prior art reference must teach or suggest all the claim limitations.

Regarding the first criterion, the Janek reference actually teaches away from the concept of a container that when secured permits movement of the container in multiple

orientations. In particular, the Janek reference describes a configuration of three latches, at least one latch secured opposite the monorail from the other two, as an “essential” aspect of the invention (column 9, lines 47 through 54). The stated objective of the system in the Janek reference is to secure the container to the monorail such that it is maintained in a single transport position when so secured (column 2, lines 48 through 52). Accordingly, it would be improper to combine the Janek reference with any other reference, including common knowledge, to achieve a container that may move when securely engaged to the surface.

As to the second criterion, the Janek reference would not be a proper § 103 reference in that there would be no reasonable expectation of success in outfitting the container of the Janek reference to move between multiple orientations when secured. As discussed above, the container of the Janek reference must be secured via at least three latches, one opposite the monorail from the others. No structure disclosed in the Janek reference teaches or suggests reorientation of the container when secured by the three essential latches. Even if reorientation were theoretically possible, the mounted container would cease to function as a mounted container as described in the Janek reference. Were the container to rotate about the monorail, the container would presumably collide with the ground when the vehicle moved, damaging the container and adversely impacting any articles within it. Were the container to translate along the monorail, the container would presumably subject the article to substantial shocks in the event the vehicle accelerated or decelerated. Were the container to rotate about the point of attachment, the container would presumably collide with the vehicle, damaging the container and the vehicle as well as jostling articles stored within the container. None of these scenarios could be considered “successful” since the container would be damaged and agitate rather than store articles, as well as potentially damaging the SUV, in every possible scenario. As such, the Janek reference fails the second obviousness criterion and would not be a proper § 103 reference.

As to the third criterion, the Janek reference would not be a proper § 103 reference, since, as discussed above regarding § 102, each and every of the applicants’ claim limitations is not disclosed directly or indirectly by the Janek reference. The Janek

reference specifically requires three latches, one opposite the monorail from the others. The Janek reference does not teach or suggest how one would achieve multiple orientations when secured in this orientation. Accordingly, the Janek reference fails the third obviousness criterion and would not be a proper § 103 reference. In summary, the Janek reference neither anticipates nor renders obvious the applicants' claimed invention. As such, the applicants respectfully request that the rejections be withdrawn as regards claims 1-12.

Claims 13-18

As to claim 13, the office action asserts as follows: "Janek discloses a method of transporting articles securely that provides a container with a lid and a receiver that engage to form a containment volume and attaching that container to a surface that allows it to be positioned in a first and second orientation..." The applicants respectfully submit that the Janek reference does not describe each and every elements of the applicants' invention.

In particular, the applicants' claim 13 includes a method for securing articles featuring a container "suitably adapted for substantially secure engagement with a surface, wherein said engagement of said container with said surface permits the container to be positioned in at least a first orientation and a second orientation." As discussed above, in the Janek reference, at least three latches must be secured, one opposite the monorail from the others. This configuration renders the container 20 fixed in a single orientation and does not permit multiple orientations of the container. The previous analysis applies equally to the analysis of claims 13-18. As such, the applicants respectfully traverse the rejection and request withdrawal of the rejections.

Claims 19-20

With respect to claim 19, the office action alleges as follows: "[t]he container securely engages with a surface 32 and may pivot from a first orientation on that surface to a second orientation approximately 90 degrees displaced (column 5, lines 26-32; figure

2).” The applicants respectfully traverse this rejection and submit that the cited portion of Janek does not disclose such a configuration.

Claim 19 requires a container “suitably adapted for substantially secure engagement with a surface, wherein said engagement of said container apparatus with said surface permits the container apparatus to be positioned in a first orientation approximately 90 degrees displaced from a second orientation.” As discussed above, when the container of Janek is secured in the manner disclosed in Janek, it cannot be reoriented. The portion cited in the office action as describing reorientation of the Janek reference states as follows: “The tub is provided with additional locking means fixed near the tub’s base, which locking means cooperate with at least one of the pivot latches. Most preferably, the locking means cooperate with both pivot latches 71 and 72 and two attachment latches 73 and 73’ either above or below the upper surface of the support beam, to secure the container.” As discussed above, however, Janek characterizes at least three latches, one opposite the monorail from the other two, as an essential minimum configuration. In view of these requirements, the tub in Figure 2 is not secured, let alone secured in an orientation approximately 90 degrees displaced from a second orientation. Accordingly, Janek does not disclose each and every limitation of claim 19. As such, Janek is not a proper § 102 reference and the rejections of claims 19 and 20 should be withdrawn. Furthermore and as discussed above, Janek would not be a proper § 103 reference because Janek fails at least one of the criteria for establishing a prima facie case of obviousness.

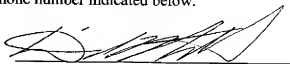
Conclusion Regarding § 102 Rejections and Potential § 103 Rejections

In view of the foregoing, the applicants submit that the Janek reference is not a proper § 102 reference inasmuch as it does not disclose all elements of the rejected claims. In addition, Janek would not be a proper § 103 reference in that Janek fails at least one of the elements of the prima facie case. Therefore, the Janek reference is an improper reference and the applicants respectfully request that the rejections be withdrawn.

CONCLUSION

In sum, the applicants respectfully submit that all claims are patentable over the cited reference and are in condition for allowance. If there are any questions or concerns, please contact the undersigned at the telephone number indicated below.

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